

**REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims. This reply is being timely submitted (the due date of January 21, 2005 being a Saturday).

***Status of the Claims***

In the present Reply, claim 1 has been amended. Also, claims 11 and 12 have been added. Thus, claims 1-12 are pending in the present application.

No new matter has been added by way of the amendment to claim 1, since the amendment is clearly editorial in nature. Further, this is a clarifying and not a narrowing amendment. By adding the terms “(a)” and “(b)” in order to clarify the claimed invention, Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

No new matter has been added with the new claims as well. New claims 11 and 12, directed to other embodiments of the present invention added for the Examiner’s consideration, have support in the specification at least at page 9, lines 7-11 and page 10, lines 10-11, respectively (see also, e.g., Figures 4 and 5 regarding new claim 12).

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the only rejection and allow the currently pending claims.

*Issues under 35 U.S.C. § 103(a)*

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sauer '639 (U.S. Patent No. 6,264,639 B1) in view of Buell '458 (U.S. Patent No. 5,330,458) (see paragraphs 1-3 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested. Generally, Applicants do not concede that a *prima facie* case of obviousness has been established.

In the present invention, the elastic members each have (a) a portion contributory to elastic extensibility and contractibility in each of the regions outside the lateral sides of the patterned sheet and (b) a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet. In other words, the elastic members also have feature (b) as recited above. Further, as can be seen from Figure 3 in Applicants' specification, the elastic members 24 in front and back portions A and B, respectively, are a continuation of elastic members 23. However, the elastic members 24 reside in the portion F (the middle portion in between lateral portions E). In other words, the present invention has "the portion substantially non-contributory to elastic extensibility and contractibility [is] disposed between the patterned sheet and the inner sheet" (see the location of feature (b) as recited in claim 1).

In contrast to the present invention, the cited primary reference of Sauer '639 fails to disclose elastic members and location thereof as instantly claimed. The Examiner refers Applicants to Figures 1 and 2 of Sauer '639 to disclose the location of elastic members, including how such elastic member are void in the central area (see last paragraph on page 2 of

the Office Action). However, this means that Sauer '639 fails to disclose "a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet" as instantly claimed. This deficiency in Sauer '639 of no elastic members in within the lateral portions of the absorbent article is in addition to how the primary reference fails to disclose a graphic on the absorbent article as stated in the Office Action at page 2, last two lines. Thus, there are multiple deficiencies in the primary reference, wherein the secondary reference of Buell '458 fails to account for such deficiencies.

Specifically, Buell '458 is cited as disclosing indicia means **118** in the waist region (wherein the Examiner refers to column 28, lines 3-20 of the reference). However, Buell '458 does not disclose the instantly claimed elastic members being in the region that is inside the lateral sides of the patterned sheet (e.g., the claimed "a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet").

Thus, the cited combination of Sauer '639 and Buell '458 fails to disclose all instantly claimed features and a *prima facie* case of obviousness has not been established. This is because U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or

process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In this regard, not even the initial requirement of disclosure of all claimed features has been satisfied. For instance, the cited combination does not disclose “a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet” as instantly claimed. Thus, this rejection under § 103(a) has been overcome.

Applicants add that the requisite motivation as well as the reasonable expectation of success are lacking.

With regard to the required level of motivation, the cited indicia means **118** of the secondary reference of Buell ‘458 is described as follows: “the reinforcing strip **116** is also preferably provided with indicia means **118** for aiding the diaperer in fitting the diaper to a wearer” (see column 27, lines 4-6), wherein the reinforcing strip **116** is disposed as the outermost layer (see also Figure 1 of the reference). Therefore, one of ordinary skill in the art would understand that indicia means **118** must be just a design or pattern printed onto the reinforcing strip **116** for aiding the diaperer in fitting the diaper to a wearer. In addition, indicia means **118** is not disposed between the outer sheet and the inner sheet differing from the present invention. Indicia means **118** is just disposed on the reinforcing strip **116** as the outermost layer. Thus, Buell ‘458 fails to disclose “the portion substantially non-contributory to elastic extensibility and contractibility is disposed between the patterned sheet and the inner sheet” feature as instantly claimed. Applicants add that the location of the portion that is substantially non-contributory to

elastic extensibility and contractibility aids in bringing about a pictorial pattern clearly seen from the outside of the absorbent article.

Furthermore, one of ordinary skill in the art, upon using the Sauer '639 and Buell '458 disclosure would not be motivated in achieving the present invention since neither Sauer '639 or Buell '458 makes any such suggestion to insert its indicia means between a pattern sheet and an inner sheet. Applicants note that the teaching or suggestion to make the claimed article and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). That is not the case here given the Buell '458 disclosure of its indicia means 118 coupled with the Sauer '639 disclosure regarding no presence of elastic members within the lateral portions of the absorbent article.

Applicants further note that the requisite motivation is missing when the Buell '458 indicia means is inserted into the Sauer '639 disclosure. There is still no elastic member(s) present in the middle portions of the absorbent article as claimed (e.g., "a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet"). Applicants add that it is not *prima facie* obvious to modify a reference unless the references suggest an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). No such suggestion of an advantage is present in either cited reference (in an effort to achieve the present invention). Thus, the requisite motivation is lacking for this additional reason.

With regard to the requisite reasonable expectation of success, Buell '458 merely discloses that indicia means **118** may be provided (see column 27, lines 3+). However, Applicants respectfully submit that this part of the Buell '458 reference does not equal disclosure to achieve the present invention because options presented amounts to an "obvious to try" rationale. Such an "obvious to try" rationale is improper for an analysis of patentability under 35 U.S.C. § 103(a). *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (CAFC 1988) (In *In re Fine*, the CAFC reversed the BPAI by stating: "The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," *but neither of them offered any support for or explanation of this conclusion.*") (emphasis added); *see also In re Deuel*, 34 USPQ2d 1210, 1216 (CAFC 1995) (where the court states: "Obvious to try" has long been held not to constitute obviousness. A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out") (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (CAFC 1988)). Thus, Applicants respectfully submit that the required level of reasonable expectation of success is lacking.

Applicants also traverse the conclusions of optimization and the application of the *In re Boesch* decision as stated at page 3 of the Office Action. This is because: "The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); *see also In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed.

Cir. 1984). Here, since no literature or evidence has been provided to show that, e.g., opacity is a matter of optimization, the burden has not shifted back to Applicants to prove otherwise.

**Unexpected Results for the Present Invention**

Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on Sauer '639, Buell '458 or any other reference or combinations thereof). *See In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); *see also In re Papesch*, 315 F.2d 381, 137 USP 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). As stated in M.P.E.P. § 2144.09 (see section entitled "*Prima Facie* Case Rebuttable By Evidence of Superior or Unexpected Results"), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention.

Here, by virtue of the nature of the claimed limitation of "the elastic members have a portion substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet," the present invention has achieved unexpected results. Specifically, such a feature enables the claimed absorbent articles to be produced at high speed with stability, which is an unexpected improvement in the state of the art. In other words, when the absorbent articles are manufactured at high speed, this claimed limitation is especially useful in that the absorbents articles are made quickly and with stability.

Therefore, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. Reconsideration and withdrawal of this rejection are respectfully requested for this additional distinction.

**Summary of Applicants' Position**

Based on the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established (e.g., no disclosure of all claimed features). In addition, or alternatively, the present invention has achieved unexpected results that rebut any rejection made under § 103(a). Accordingly, Applicants respectfully request reconsideration, withdrawal of this rejection and allowance of the currently pending claims.

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.



**Application No. 10/784,197**

**Docket No.: 0445-0347P**

**Art Unit 3761**

**Reply to Office Action of October 21, 2005**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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